

### Remarks

Claims 1, 36 and 59 are amended herein. Claims 1-3, 5-7, 10-62 and 64-74 remain pending in the Application. No new matter has been added as a result of the Claim amendments.

### Rejection under 103(a)

#### Claims 1-3, 5-7, 10-62 and 64-74

In the Office Action, Claims 1-3, 5-7, 12-16, 18-21, 23-24, 28-29, 33, 36, 40-42, 44, 47-51, 53, 55, 57, 59, 61-62, 66, 68 and 71-74 are rejected under 35 USC 103(a) as being unpatentable over Van Diggelen (6,587,789) in view of Fan (5,959,577). Applicants have reviewed the cited references and respectfully submit that the present invention is not rendered obvious over Van Diggelen in view of Fan for the following rationale.

Applicants respectfully submit that Claim 1 ( and similarly Claims 36 and 59) includes the feature, "a mobile unit including a positioning system receiver and a data processing unit, said mobile unit accessing said network and receiving said data file without providing any location information to said information processing station, said mobile unit selecting a portion of said data file correlating to satellites being in line-of-sight of said mobile unit and utilizing said portion of said data file to assist in computing a measured position of said mobile unit" (emphasis added).

Support for the Claimed feature can be found throughout the Specification and Figures including page 9 lines 8-17, page 22 lines 13-25 and page 23 lines 1-15.

**To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (MPEP 2143.03).**

Applicants respectfully submit that neither Van Diggelen alone or in combination with Fan teach or render obvious the feature, “a mobile unit including a positioning system receiver and a data processing unit, said mobile unit accessing said network and receiving said data file without providing any location information to said information processing station, said mobile unit selecting a portion of said data file correlating to satellites being in line-of-sight of said mobile unit and utilizing said portion of said data file to assist in computing a measured position of said mobile unit” (emphasis added).

For this reason, Applicants respectfully submit that independent Claims 1, 36 and 59 overcome the rejection under 35 U.S.C. § 103(a), and that these claims are thus in a condition for allowance.

Furthermore, Applicants respectfully point out that in order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention (MPEP 2142). In particular, “[i]t is improper to combine references where the references teach away from their combination” (emphasis added; MPEP 2145(X)(D)(2); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Applicants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Applicants respectfully submit that there is no motivation to combine the teachings of Van Diggelen and Fan, because Van Diggelen teaches away from the suggested modification.

As described above, Applicants respectfully assert that nowhere does Van Diggelen teach or describe a system, “a mobile unit including a positioning system receiver and a data processing unit, said mobile unit accessing said network and receiving said data file without providing any location information to said information processing station, said mobile unit selecting a portion of said

data file correlating to satellites being in line-of-sight of said mobile unit and utilizing said portion of said data file to assist in computing a measured position of said mobile unit" as claimed in independent Claim 1 and similarly recited in Claims 36 and 59.

Instead, Applicants understand Van Diggelen to teach, including 510 of Figure 5, the central processing unit computes the satellites and transfers the data after obtaining the approximate location of the mobile unit. As such, Applicants respectfully submit that Van Diggelen teaches away from the claimed feature of "the mobile unit accessing said network and receiving said data file without providing any location information to said information processing station" (emphasis added).

As such, Applicants respectfully assert that there is no motivation or suggestion to combine these teachings. By teaching that the location of the mobile device is needed prior to performing any calculation or providing any data, Applicants respectfully assert that Van Diggelen teaches away from combination with Fan. Applicants respectfully note that the Van Diggelen reference must be considered in its entirety in determining whether there is motivation or suggestion to combine Fan with Van Diggelen. Accordingly, the aforementioned limitations are not taught or suggested by Van Diggelen and thus an essential element needed for a prima facie rejection based on the cited references is not present.

In view of the combination of Van Diggelen in view of Fan not showing or suggesting all of the limitations of independent Claims 1, 36 and 59, not satisfying the requirements of a *prima facie* case of obviousness, Applicants respectfully submit that independent Claims 1, 36 and 59 overcome the rejection under 35 U.S.C. § 103(a), and that these claims are thus in a condition for allowance. Applicants respectfully submit the combination of Van Diggelen in view of Fan also does not teach or suggest the additional claimed features of the present invention as recited in Claims 3, 5-7, 12-16, 18-21, 23-24, 28-29, 33, 40-

42, 44, 47-51, 53, 55, 57, 61-62, 66, 68 and 71-74 that depend from independent Claims 1, 36 and 59. Therefore, Applicants respectfully submit that Claims 3, 5-7, 12-16, 18-21, 23-24, 28-29, 33, 40-42, 44, 47-51, 53, 55, 57, 61-62, 66, 68 and 71-74 also overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance as being dependent on an allowable base claim.

Claims 17, 25-27, 38-39, 43, 52, 60, 65 and 67

In the Office Action, Claims 17, 25-27, 38-39, 43, 52, 60, 65 and 67 are rejected under 35 USC 103(a) as being unpatentable over Van Diggelen (6,587,789) in view of Fan (5,959,577) in view of Twitchell (6222483). Applicants have reviewed the cited references and respectfully submit that the present invention is not rendered obvious over Van Diggelen in view of Fan in view of Twitchell for the following rationale.

Applicants respectfully note that Claims 17, 25-27, 38-39, 43, 52, 60, 65 and 67 depend from Independent Claims 1, 36 and 59 and therefore benefit from like argument, incorporated herein by reference.

Therefore, Applicants respectfully submit that Claims 17, 25-27, 38-39, 43, 52, 60, 65 and 67 also overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance as being dependent on an allowable base claims.

Claims 10-11, 30-35, 45-46 and 69-70

In the Office Action, Claims 10-11, 30-35, 45-46 and 69-70 are rejected under 35 USC 103(a) as being unpatentable over Van Diggelen (6,587,789) in view of Fan (5,959,577) in view of Sheynblat (6583756). Applicants have reviewed the cited references and respectfully submit that the present invention is not rendered obvious over Van Diggelen in view of Fan in view of Sheynblat for the following rationale.

Applicants respectfully note that Claims 10-11, 30-35, 45-46 and 69-70 depend from Independent Claims 1, 36 and 59 and therefore benefit from like argument, incorporated herein by reference.

Therefore, Applicants respectfully submit that Claims 10-11, 30-35, 45-46 and 69-70 also overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance as being dependent on an allowable base claims.

#### Claims 37 and 64

In the Office Action, Claims 37 and 64 are rejected under 35 USC 103(a) as being unpatentable over Van Diggelen (6,587,789) in view of Fan (5,959,577). Applicants have reviewed the cited references and respectfully submit that the present invention is not rendered obvious over Van Diggelen in view of Fan for the following rationale.

Applicants respectfully note that Claims 37 and 64 depend from Independent Claims 36 and 59 and therefore benefit from like argument, incorporated herein by reference.

Therefore, Applicants respectfully submit that Claims 37 and 64 also overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance as being dependent on an allowable base claims.

Moreover, regarding the statement on Page 8 section 5, the present Office Action states: "Examiner takes an official notice that the number of satellites depends on the availability of the satellites and the design of the satellite system and changing the number of satellites from 28 to 24 does not alter the scope of the invention." Applicants respectfully disagree with the Examiner's assertion regarding the system as recited in Claims 37 and 64. As such, Applicants respectfully request that the Examiner produce authority for this assertion in conjunction with the system as recited in Claim 37 and 64.

### Claims 22 and 56

In the Office Action, Claims 22 and 56 are rejected under 35 USC 103(a) as being unpatentable over Van Diggelen (6,587,789) in view of Fan (5,959,577). Applicants have reviewed the cited references and respectfully submit that the present invention is not rendered obvious over Van Diggelen in view of Fan for the following rationale.

Applicants respectfully note that Claims 22 and 56 depend from Independent Claims 1 and 36 and therefore benefit from like argument, incorporated herein by reference.

Therefore, Applicants respectfully submit that Claims 22 and 56 also overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance as being dependent on an allowable base claims.

Moreover, regarding the statement on Page 9 section 6, the present Office Action states: "Examiner takes an official notice that a T1 link is a landline. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the landline link in the modified Diggelen's invention with a T1 link in order to increase the speed and capacity of the data transmission." Applicants respectfully disagree with the Examiner's assertion regarding the system as recited in Claims 22 and 56. As such, Applicants respectfully request that the Examiner produce authority for this assertion in conjunction with the system as recited in Claim 22 and 56.


Conclusion

In light of the above amendments and remarks, Applicant respectfully requests allowance of Claims 1-3, 5-7, 10-62 and 64-74.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present application.

Respectfully submitted,  
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